



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**ROSSI, KIMMS & McDOWELL LLP.**  
**20609 Gordon Park Square, Suite 150**  
**Ashburn VA 20147**

**MAILED**

**DEC 13 2010**

**OFFICE OF PETITIONS**

In re Application of: :  
Shui-On Leung et al. :  
Application No. 09/988,013 : PETITION DECISION  
Filed: November 16, 2001 :  
Attorney Docket No. IMMU:014US2 :

This is a decision on the petition filed August 30, 2010 which is being treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131.

The petition is **DISMISSED**.

The application as-filed identified two inventors as the inventive entity: Shui-On Leung and Hans Hansen. Petitioner requests that the Office accept a declaration under 37 CFR 1.131 by Hansen without requiring a similar declaration signed by Leung who is alleged to be unavailable.

MPEP 715.04(I) states in part:

Where one or more of the named inventors of the subject matter of the rejected claim(s) (who had originally signed the oath or declaration for patent application under 37 CFR 1.63) is now unavailable to sign an affidavit or declaration under 37 CFR 1.131, the affidavit or declaration under 37 CFR 1.131 may be signed by the remaining joint inventors provided a petition under 37 CFR 1.183 requesting waiver of the signature of the unavailable inventor be submitted with the affidavit or declaration under 37 CFR 1.131. Proof that the non-signing inventor is unavailable or cannot be found similar to the proof required for a petition under 37 CFR 1.47 must be submitted with the petition under 37 CFR 1.183 (see MPEP § 409.03(d)). Petitions under 37 CFR 1.183 are decided by the Office of Petitions (see MPEP § 1002.02(b)).

Since petitioner is alleging that Leung is refusing to sign the declaration, at the very least, petitioner should mail correspondence to the non signing inventor's last known address, return receipt and/or forwarding address requested. If a forwarding address is provided, petitioner should then mail a complete copy of the declaration to Leung's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct.

It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

Petitioner has not demonstrated that the non-signing inventor, Leung, refuses to sign the declaration. The petition references a declaration by Bryan Wilson which indicates that Gregory Lantier informed Wilson that Leung refused to sign the 131 declaration.

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration **by the party to whom the refusal was made**. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration. Therefore, based on the information given above, an affidavit or declaration by Gregory Lantier would be required.

When it is concluded that an inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an inventor gives a reason for refusing to sign the declaration, that reason should be stated in the affidavit or declaration.

Telephone inquiries concerning this matter should be directed to Carl Friedman at (571) 272-6842.



Carl Friedman  
Petitions Examiner  
Office of Petitions